

: U.S. Application Serial No. 10/576,242  
Atty. Docket No. 10191/4700  
Reply to Office Action of October 14, 2008

### REMARKS

Claims 30 to 34 are added, and therefore claims 16 to 34 are pending in the present application.

Applicants thank the Examiner for considering the Information Disclosure Statement and indicating that all certified copies of the foreign priority documents have been received.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

It is noted that claims 26 to 29 have been rewritten (without regard to the rejections) to better clarify the claimed subject matter. No new matter is added, and approval and entry are respectfully requested.

Claims 16 to 21, 23 to 27 and 29 were rejected under 35 USC § 102(b) as anticipated by U.S. Patent No. 5,898,402 (“Kilpatrick”).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claims 16, 26 and 29 each include the features of an antenna amplifier comprising “an input for connecting to an antenna,” “an output for connecting to a receiver,” and “an arrangement for providing signal-level matching between the input and the output.” Claims

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16, 26 and 29 further include the feature of “a narrow-band filter situated between the input and the arrangement for providing signal-level matching, wherein a pass frequency of the narrow-band filter is configured to be tuned to a receive channel of the receiver.”

As clearly provided for in the context of claims 16, 26 and 29, the subject matter of the presently claimed subject matter relates to an antenna amplifier which has an input for connecting to an antenna and an output for connecting to a receiver. The amplifier includes an arrangement that provides for signal-level matching between the input and the output. Additionally, the amplifier includes *a narrow-band filter situated between the input and the matching arrangement*, wherein *a pass frequency of the narrow-band filter* is configured to be tuned to a receive channel of the receiver.

In contrast, the Kilpatrick reference does not identically describe (or even suggest) a narrow-band filter situated between the input and the matching arrangement, e.g., *between the antenna and the receiver*. The Office Action cites the abstract of Kilpatrick, in which supposedly inherently matched filters are mentioned in passing. However, the cited portion only refers to processing steps performed *downstream of the receiver*, after an analog signal is received and converted to a digital signal. Thus, any such matched filters cannot possibly be considered to be situated between the input (for connecting to the antenna) and the matching arrangement (between the input and the output to the receiver) -- that is, between the antenna and the receiver.

Additionally, the Kilpatrick reference does not identically describe (or suggest) the feature in which *a pass frequency of the narrow-band filter is configured to be tuned to a receive channel of the receiver*. The Office Action cites a portion of Kilpatrick which refers to a bandpass filter that (similar to the supposedly inherently matched filters previously discussed) is not located *between the input and the matching arrangement*. Further, Kilpatrick explicitly defines the term “channel” so that it should not be construed as similar in any way to the *receive channel* provided for in the claims. Specifically, Kilpatrick defines the term “channel” as consisting of a phase matched set of an antenna, an amplifier, a coaxial cable, and a receiver” (col. 2, lines 6 to 9). Further still, Kilpatrick’s objectives are completely at odds with those of the presently claimed subject matter. Kilpatrick’s system is designed to evaluate *unknown* signal characteristics of a received signal, including, e.g., *frequency and modulation*. Clearly, it would be impossible to tune to a receiving channel using Kilpatrick’s system, since signal characteristics of the received signal are not known in

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advance. For these reasons, the Kilpatrick reference does not identically disclose (or even suggest) the feature in which *a pass frequency of the narrow-band filter is configured to be tuned to a receive channel of the receiver.*

Accordingly, it is respectfully submitted that claims 16, 26 and 29, as presented, are allowable.

Claims 17 to 21 and 23 to 25 depend from claim 16, and claim 27 depends from claim 26. Accordingly, claims 17 to 21 and 23 to 25 and claim 27 are allowable for the same reasons as their respective base claims 16 and 26.

Accordingly, it is respectfully submitted that claims 16 to 21, 23 to 27 and 29 are allowable.

Withdrawal of the anticipation rejections is therefore respectfully requested.

Claims 22 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kilpatrick in view of U.S. Patent No. 4,531,232 (“Sakurai”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

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As explained above, the Kilpatrick reference does not disclose (or even suggest) all of the features of claims 16 and 26, as presented. Claim 22 depends from claim 16, as presented, and claim 28 depends from claim 26, as presented. Claims 22 and 28 are therefore allowable for at least the same reasons as their respective base claims 16 and 26, since Sakurai does not cure -- and is not asserted to cure -- the critical deficiencies of the Kilpatrick reference.

Withdrawal of the obviousness rejections of the claims is therefore respectfully requested.

*New claims 30 to 34 do not add any new matter and are supported by the present application, including the specification. Claim 30 depends from claim 29, and is therefore allowable at least for the same reasons. Claim 31 depends from claim 16, and is therefore allowable at least for the same reasons, as are its dependent claims 32 and 33. Claim 34 depends from claim 26, and is therefore allowable at least for the same reasons.*

*Additionally, each of claims 29, 30 and 34 include features which are not identically described (or even suggested) by the references as applied. In particular, each of these claims further provide that the antenna amplifier further includes a device for one of splitting up and filtering out signal components of a received signal at the output of the antenna amplifier, the pass frequency of the narrow-band filter is tuned via a tuning signal that is generated by the receiver and applied to the output of the antenna amplifier, the tuning signal applied to the output of the antenna amplifier is evaluated in the antenna amplifier, the tuning signal is one of a d.c. voltage, an analog amplitude-modulated signal, an analog frequency-modulated signal, an analog pulse-width-modulated signal, and a digital data stream, a supply voltage for the antenna amplifier is applied to the output of the antenna amplifier, the device for one of splitting up and filtering out signal components of the received signal includes a storage unit for storing tuning information, and further control signals are applied to one of a control terminal of the antenna amplifier and the output of the antenna amplifier.*

In sum, claims 16 to 34 are allowable.

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### CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

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